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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,524	02/09/1999	AMIT R. SHAH	2870/72	8887

7590 09/18/2002  
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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/18/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/248,524

Applicant(s)

SHAH, AMIT R.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of the response filed July 9, 2002. Claims 1-22 are pending. No claims have been amended.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide a written description of a flow-through cosmetic applicator. This rejection is maintained.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of the claims as indefinite because of the relative term "long-wearing" is maintained for reasons of record in paper no. 20.

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Claims 1-4, 6-13 and 15-21 are indefinite because it is unclear what Applicant intends to encompass by the term "derived." This rejection is maintained for reasons of record.

Claims 15-18 are indefinite because it is unclear what Applicant intends by a flow-through cosmetic applicator. This rejection is maintained for reasons of record in paper no. 20.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 (072).

This rejection is maintained for reasons of record in paper no. 20.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 (072) in combination with US 4,761,277 (277).

This rejection is maintained for reasons of record in paper no. 20.

### ***Response to Arguments***

Applicant's arguments filed July 9, 2002 have been fully considered but they are not persuasive. All of Applicant's arguments were previously presented in the amendment filed January 24, 2002, paper no. 18, and considered in the Office Action mailed April 9, 2002, paper no. 20.

The Examiner notes that arguments addressing the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection of claims 15-18 have not been set forth specifically and individually. The Examiner believes this to be a proper rejection for reasons of record in paper no. 20.

Applicant argues that the term "long-wearing" is defined clearly and concisely by the specification as up to a full day. This is a relative term that is not defined by any lower limit in the claims or the specification. If one of ordinary skill in the art cannot determine the lower limit of long-wearing, how can one determine if a composition is not long-wearing?

Applicant argues that the term "derived" is known and understood by one of ordinary skill in the art. Although one of ordinary skill in the art would understand the term "derived," it is not clear how this term is used in the context of the instant claims. For example, does Applicant intend to claim acrylic acid polymers or polymers derived from acrylic acid? If Applicant intends to claim polymers derived from acrylic acid, to what extent are the polymers derived?

It appears that Applicant has coalesced the arguments of both 35 U.S.C. 103(a) rejections. The Examiner will address each argument separately below.

Applicant appears to argue that US '072 does not teach or suggest water-soluble pigments. Although US '072 does not disclose water-soluble organic pigments *per se*, as stated in paper no. 20, US '072 teaches D&C Yellow No. 5, which is a water-soluble pigment, at column 6, lines 26-27.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the teachings of US '072 with US '277 is to provide colored cosmetic compositions that can be easily applied to the eye area.

Applicant argues that US '277 teaches away from the combination of the cited prior art because it teaches that the use of waxes, oils and fats cause clogging. Firstly, this argument is not commensurate in scope with the instant claims. The claims do not contain any limitations addressing the issues of clogging or a wick-type nib. US '277 teaches that nib pens are known for delivery of cosmetic compositions (col. 1, lines 12-14). US '277 also teaches that a specific viscosity allows the use of any ingredients in nib pen applicators (col. 1, lines 47-50). US '277 does not clearly and specifically teach that compositions containing waxes and anhydrous or oil bases cannot be used in nib pen applicators. It is the Examiner's position that US '277 does not teach away from the use of the composition of US '072 in nib pen applicators.

Applicant argues that the method of simply combining the acrylic acid or methacrylic acid polymer component with the water-soluble organic pigments is not taught by the elaborate polymeric systems taught by the prior art. The method claims contain the open language "comprising", which allows for additional steps. Two ingredients that are old and well-known are obvious to combine. No ordered steps are

set forth in the claims, which reads on simple mixing, which is obvious to one of ordinary skill in the art. Therefore, no criticality is seen in the step of combining the two components as in the instant claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

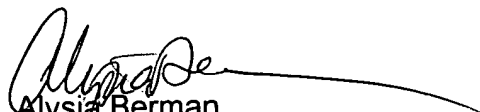
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

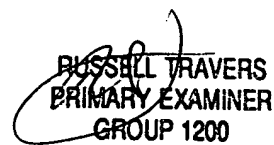
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
September 16, 2002

  
RUSSELL TRAVERS  
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